



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,135	09/11/2003	Hugh Sloan West JR.	P/3988-24	7746

7590 10/24/2008  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, NY 10036-8403

EXAMINER
----------

NGUYEN, VI X

ART UNIT	PAPER NUMBER
----------	--------------

3734

MAIL DATE	DELIVERY MODE
-----------	---------------

10/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/661,135

Applicant(s)

WEST ET AL.

Examiner

Victor X. Nguyen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,7,8,11-17 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,7,8,11-17 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The request filed on 7/28/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/661,135 is acceptable and a RCE has been established. An action on the RCE follows.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4,7-8,11-17 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (6,149,669) in view of West, Jr. et al (5,964,764).

Li discloses in figures 8-10, abstract and col. 7, lines 4-64, a suture anchor 20 having the limitations as recited in the above listed claims, including: a borehole is formed in a first tissue, a suture is threaded through a second tissue for forming a loop in the suture with the tissue, the step of attaching the two suture portions to the anchor 20 whereby the two suture portions is threaded through the anchor and initially movable with respect to the anchor, and providing a force to a shaft 42 of the anchor, the force will cause clamping of the two suture portions in the anchor and deformation of a deformable portion of the anchor, where the deformation causes the deformable portion to engage a wall of the borehole thereby to secure the suture anchor to the first tissue and the loop holding the second tissue to the suture anchor, and where the step of clamping comprises providing a spacing between two clamping members in the anchor and frictionally

Art Unit: 3734

engages at least one of the two suture portions between the clamping members when the force is applied to the suture anchor. Li is silent regarding to provide a convoluted path for at least one of the two suture portions in the anchor. West, Jr teaches to provide a convoluted path for at least one of the two suture portions in the anchor (figures 2-3, element 36). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Li by providing a convoluted path for at least one of the two suture portions in the anchor as taught by West, Jr in order to prevent inadvertent removal of the suture during insertion and deployment of the anchor device. As to claims 15 and 17, West, Jr teaches the convoluted path is U-shaped (see fig. 3), and where the step of comprising locking 30 to the deformation portion and shaft together to ensure the two suture portions is securely held to the anchor, wherein the step of an engaging portion 30 with a wall of a borehole 50, a shaft 42 extends from the engaging portion, where a suture retaining portion at 63 is able to retain the suture portions with a loop (see col. 7, lines 21-24), where a concentric member 46 disposes about a portion of the shaft, and where the application of a force which is able to move the shaft with respect to the concentric member that allows to clamp at least two suture portions in the suture retaining portion at 63 thereby to secure the suture forming the loop in the suture retaining portion and secure the second tissue to a suture anchor 20. As to claim 14, Li discloses in figures 8-10 a method of securing the tissues with an anchor as described in the above claim and further including a deformation at best seen in figure 9,10 where the step of actuation of the fingers 48, 49 would cause a deformation to engage a wall of the borehole thereby to secure the suture anchor 20.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

/Victor X Nguyen/  
Examiner  
Art Unit 3734

VN